

REMARKS

After entry of this request for reconsideration, claims 1-20 are pending in the application. None of the pending claims have been amended or cancelled by this Request for Reconsideration. This Request for Reconsideration is submitted to place the application in better form for appeal and to comply with 37 C.F.R. § 1.144 by requesting reconsideration prior to petitioning the Commissioner.

In the Office Action dated March 14, 2003, claims 9-20 were withdrawn from consideration by the Examiner pursuant to 37 C.F.R. § 1.142(b) and MPEP § 821.03. The Examiner's basis for withdrawing claims 9-20 is not supported by the appropriate standard for defining inventions distinct from and independent of one another. The Examiner states that the "Claims 9-20 are drawn to the invention of a method of making attachment to a goalie skate as a non-elected species by original presentation." The fact that claims 1-8 are drawn to an apparatus and claims 9-20 are drawn to a method is not a legitimate basis for a restriction requirement. The statutory basis for a restriction requirement is the presence of two or more independent and distinct inventions claimed in one national application. 35 U.S.C. § 121, 37 C.F.R. § 1.141, M.P.E.P. § 802. Where claims are drawn to a product and process for making the product are included in an application, a restriction requirement can only be imposed if the product and the process are shown to be distinct. 37 C.F.R. § 1.141(b).

Claims 1-8 and 9-20 are related as a product and a method for making the product. M.P.E.P. § 806.05(f) states that a process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products, or (2) that the product as claimed can be made by another and materially different process.

The process of claim 9 recites integrally forming a protective shell with respect to the sole for receiving a goalie ice skate boot including a toe portion adjacent a first end of the sole and a heel portion adjacent the second end, and

extending in a first direction from the sole and integrally forming a blade holder with respect to the sole and the protective shell including an open-ended groove for receiving a blade subsequent to being formed with sole and the protective shell, the blade holder also including at least one bore extending transverse to the open-ended groove and adjacent one of the toe portion and the heel portion to receive a fastener for releasibly associating a blade with respect to the integrally formed sole, protective shell and blade holder. The product of claim 1 recites a holder unitarily formed as part of the sole of the shell and a blade received in the open-ended groove after the holder has been unitarily formed with respect to the shell. It is submitted that the process of claim 9 cannot be used to make other and different products than the product recited in claim 1 and the product as recited in claim 1 cannot be made by another and materially different process than the process recited in claim 9. It is therefore submitted that restriction between claims 1-8 and 9-20 is improper since a single invention is claimed under the guidelines set forth in M.P.E.P. § 806.05(f).

The Examiner relies on M.P.E.P. § 821.03 to withdraw the method claims since method claims were not originally presented. However, M.P.E.P. § 821.03 does not support the Examiner's position. In particular, M.P.E.P. § 821.03 does not suspend or eliminate the fundamental requirement of all restriction requirements that a restriction requirement can only be made between independent and distinct inventions. 35 U.S.C. § 121, 37 C.F.R. § 1.141, M.P.E.P. § 802. M.P.E.P. § 821.03 cites 37 C.F.R. § 1.145 which specifically states "claims directed to an invention distinct from and independent of the invention previously claimed" can be subject to a restriction requirement. (Emphasis added). In the present matter, the Examiner has not shown claims 9-20 are directed to an invention distinct from and independent of the invention previously claimed in claims 1-8.

It is therefore submitted that the restriction requirement is improper. Pursuant to 37 C.F.R. § 1.144, the Applicants request that the restriction requirement be withdrawn, that the Examiner rejoin claims 9-20, and that the Examiner issue an action on the merits with respect to claims 9-20.

The Examiner's reconsideration is also requested pursuant to M.P.E.P.

§ 716.01. In particular, a Declaration from one of the Applicants was submitted in response to the previous Office Action. Under M.P.E.P. § 716.01, the Examiner is required to "specifically explain why the evidence [submitted traversing rejections] is insufficient" to overcome the rejection. The Examiner's duty to explain is not permissive. In the "Response to Arguments" on page 5 of the Office Action, the Examiner does not explain how the Declaration, which directly traverses the Examiner's alleged motivation to combine references, is insufficient to overcome the prima facie case for obviousness. In particular, the Declaration sets forth that incorporating a replaceable blade structure with an existing skate chassis does not increase the force opposing deformation of the blade given by transverse force. The Examiner has based the prima facie case for obviousness on the assertion that the proposed combination increases the force opposing deformation of the blade given by transverse force. Thus, the Declaration establishes that the Examiner's assertion is objectively incorrect. Furthermore, the record contains no evidence to support the Examiner's assertion or to challenge the Declaration submitted by the Applicant. The ultimate determination of patentability must be based on the entire record by a preponderance of the evidence. MPEP § 2142. In this case, there is no evidence supporting the Examiner's position regarding motivation to combine and the prima facie case for obviousness fails. It is therefore requested, pursuant to M.P.E.P. § 716.01, that the Examiner explain why the Declaration is alleged to be insufficient to overcome the rejection or withdraw the rejection.

The arguments raised in support of the patentability of the claims raised in response to the previous action are incorporated by reference as if restated herein. Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Graff, U.S. Patent No. 6,421,934, in view of Reynolds, U.S. Patent No. 6,019,622. The Examiner states that Graff teaches the invention except for at least two transversely extending bores formed in the holder, apertures formed in the legs and fasteners engageable through the apertures in the legs of the blade and the bores in the holder to removably affix the blades of the holder. The Examiner further states that Reynolds discloses a holder having two transversely extending bores and a blade

having apertures and legs and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the skate boot and getting up aid for such escape boot of Graf with the ice skate chassis having at least two transverse bores, apertures and fasteners as taught by Reynolds in order to increase the force opposing the formation of the blade given by the transverse force. This rejection has been maintained from the previous Office Action.

With respect to the Examiner's response to arguments in the Office Action dated March 14, 2003, the Applicant traverses the Examiner's assertion that Graf discloses a shell with a holder having an open-ended groove extending lengthwise to receive a blade. Graf teaches a skate wherein the blade is insert-molded with respect to the skate. The skate does not define an open-ended groove. An open-ended groove never exists in the skate of Graf in solid form to receive a blade because the blade is insert molded. In an insert molding process, a rigid structure or "insert" is placed in a mold cavity and a stream of liquid plastic is injected into the mold cavity. The liquid plastic usually encircles at least a portion of the insert; the liquid plastic forming the skate boot 1 of Graf encircles the blade 2 during the molding process. The liquid plastic is cured and, upon curing, assumes the shape defined by the interior surfaces of the mold cavity and the exterior surfaces of the insert positioned in the mold cavity. The finished part usually includes a plastic portion immovably associated with the insert; this relationship exists between the skate boot 1 and blade 2 of Graf. If the blade 2 is not placed in the mold cavity before the injection of liquid plastic, a notch for receiving a blade would not be formed by the skate boot 1 of Graf.

It is submitted that the present Request for Reconsideration should be entered by the Examiner. In particular, this Request for Reconsideration does not raise new issues for further search and/or consideration by the Examiner. This Request for Reconsideration does not raise the issue of new matter. This Request for Reconsideration does not add new claims or amend any of the claims. This Request for Reconsideration was not previously entered because the Examiner had not previously failed to consider the Declaration submitted in response to the first Office

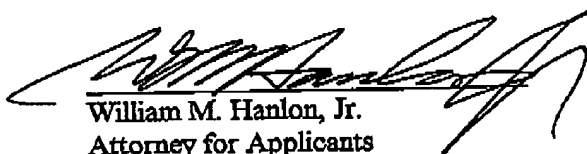
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Action by the Applicants nor had the Examiner improperly imposed a restriction requirement. It is further submitted that the claims of the present application are in suitable condition for allowance; notice of which is respectfully requested.

Respectfully submitted,

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Dated: May 5, 2003
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